

REMARKS

Reconsideration of the allowability of the present application is respectfully requested.

Status of the Claims

Claims 1, 3 and 26-28 were acted on by the Examiner. Claims 26-28 were withdrawn by the Examiner as being directed to a non-elected invention. Claims 33-39 were added. No claims have been amended. No claims have been canceled. Accordingly, Claims 1, 3, and 33-39 are presented for examination.

Support for Claim 33 can be found in the specification in Example 2; and on page 28, lines 1-11. Support for Claim 34 can be found in the specification in Original Claim 9. Support for Claims 35 and 36 can be found in the specification in Example 4; and on page 20, lines 17-27. Support for Claim 37 can be found in the specification in Original Claim 26; and on page 40, lines 5-19. Support for Claim 38 can be found in the specification in Original Claim 27; and on page 41, lines 15-24. Support for Claim 39 can be found in the specification in Original Claim 28; and on page 41, lines 15-24.

ARGUMENTS

Election/Restriction

The Examiner has objected to Claims 26-28, as amended, as being drawn to a non-elected invention. These claims have been withdrawn.

New Claims 37-39 are composition claims that claim a pharmaceutical composition comprising a nucleic acid sequence encoding an NFIF polypeptide comprising an amino acid sequence of Figure 1 (SEQ ID NO: 1). Accordingly, these claims are directed to the elected invention group I.

The §102(e) Rejections

The Examiner has rejected Claims 1 and 3 under 35 U.S.C. §102(e) as being anticipated by Bandman et al. (U.S. Patent Nos. 6,132,964 and 6,518,029). In particular, the Examiner asserts that both the '964 and '029 patents disclose a polynucleotide of 1764 base pairs in length (SEQ ID NO: 13 in both patents) that is 99.9% identical to SEQ ID NO: 3 of the instant application. The Examiner further asserts that absent evidence to the contrary the polynucleotide of Bandman et al. is an isolated nucleic acid encoding NFIF-14b polypeptide comprising an amino acid sequence as shown in Figure 1.

Applicants respectfully traverse the rejection.

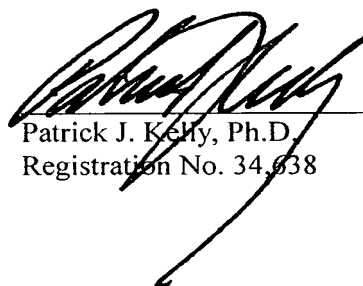
The Examiner argues that both Bandman et al. patents disclose a nucleic acid encoding NFIF-14b. Applicants respectfully disagree. As the Examiner concedes, the nucleotide sequence of Bandman et al. (SEQ ID NO: 13 in both patents) is not identical to SEQ ID NO: 3 of the present invention. There is a single nucleotide difference between SEQ ID NO: 13 of Bandman et al. and SEQ ID NO: 3 of the instant invention. Applicants refer the Examiner to Exhibit B submitted with June Kaplow's 37 C.F.R. § 1.131 Declaration submitted April 19, 2004 (the reading frame of the nucleotide sequence disclosed in Sugano et al. is identical to the reading frame of the nucleotide sequence disclosed by Bandman et al.). A comparison of the two sequences reveals that Applicants' sequence contains the codon TCT (at nucleotides 481-483 of SEQ ID NO: 3) whereas the sequence from Bandman et al. (at the equivalent distance from the start codon) contains the codon CCT (at nucleotides 549-551 of SEQ ID NO: 13 in both Bandman et al. patents). TCT is the codon for serine, while CCT codes for proline. As a result, the nucleotide sequences disclosed in both Bandman et al. patents would encode a proline at position 161 rather than a serine as disclosed in Figure 1 (SEQ ID NO: 1) of the instant application. As the sequences of Bandman et al. do not encode an amino acid sequence of NFIF-14b as shown in Figure 1 (SEQ ID NO: 1) of the instant application, neither Bandman et al. patent anticipates Claim 1 or 3. Accordingly, Applicants respectfully request that these §102(e) rejections be withdrawn.

New Claims 37-39 are composition claims that claim a medicament comprising a nucleic acid sequence encoding an NFIF-14b polypeptide comprising an amino acid sequence of Figure 1 (SEQ ID NO: 1). Thus, New Claims 33-39 contain a recitation to the same nucleic acid as in Claim 1. Accordingly, these new claims are not anticipated by either Bandman et al. reference.

A prompt and favorable action is respectfully requested.

The Commissioner is authorized hereby to charge any fees or credit any overpayment associated with this Reply (copy enclosed) to Deposit Account Number 19-5425.

Respectfully submitted,



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